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Patent
Attorney's Docket No. 012712-131

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of)

Darrell R. ANDERSON)

Application No.: 08/487,550)

Filed: June 7, 1995)

For: MONKEY MONOCLONAL ANTIBODIES)
SPECIFIC TO HUMAN B7.1 AND/OR)
B7.2 PRIMATIZED FORMS THEREOF,)
PHARMACEUTICAL COMPOSITIONS)
CONTAINING, AND USE THEREOF)
AS IMMUNOSUPPRESSANTS)

Group Art Unit: Unassigned

Examiner: Unassigned

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& APPEALS

PETITION TO CORRECT INVENTORSHIP
UNDER 37 C.F.R. §1.48(a)

Assistant Commissioner of Patents
Washington, D.C. 20231

Sir:

It is respectfully requested that the inventorship of the above-identified application, U.S. Serial No. 08/487,550 filed on June 7, 1995 and entitled "MONKEY MONOCLONAL ANTIBODIES SPECIFIC TO HUMAN B7.1 AND/OR B7.2...IMMUNOSUPPRESSANTS" be corrected. The patent application incorrectly names Darrell R. Anderson as the sole inventor. By the present Petition, it is requested that Peter Brams, Nabil Hanna and Bill Shestowsky be added as co-inventors. This request is made because the patent application, as originally filed, inadvertently failed to include these persons each of whom made an inventive contribution to one or more claims of the above-identified patent application.

The present Petition, as required under 37 C.F.R. §1.48(a) is accompanied by a signed Declaration by each inventor as re-

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quired under §1.63, a Verified Statement of Facts signed by the original named inventor, Darrell R. Anderson, the requisite fee as required by §1.17(h) and the written assent of the Assignee, IDEC Pharmaceutical Corporation.

The facts concerning the inventorship error are as follows. I am the patent attorney who had primary responsibility for drafting and finalizing the above-identified application prior to filing of this application in the Patent and Trademark Office on June 7, 1995. Typically, in drafting patent applications I am provided disclosure information by the inventor/inventors which may or may not identify the inventive contribution of each individual. This information is relied upon to draft a patent specification and claims which are forwarded to the inventor/inventors for their review and comment. The application is then revised in view of the comments of the inventor/inventors, a revised draft is forwarded to the inventor or inventors for their second review, and if acceptable the application is then filed in the Patent and Trademark Office.

In the present case, prior to filing of this application I was similarly provided disclosure information by the present Assignee relating to the claimed invention. Moreover, I was advised to direct any questions concerning the disclosure to Darrell R. Anderson, and also concerning the review of the patent application prior to filing in the Patent and Trademark Office. Accordingly, I used the provided disclosure information to compile a draft patent application. This draft application was then forwarded to Darrell R. Anderson on or about June 4, 1995, for his review and comment.

Normally, inventors are given ample time to review the draft application prior to the time that the application is to be filed in the patent and Trademark Office. Moreover, sufficient time is allocated to resolve inventorship issues prior to the filing of the patent application. However, in the present case because of time constraints attributable to the recent change in the U.S. Patent Law by GATT which went into effect on June 8, 1995 the draft patent application was sent to Darrell R. Anderson only several days prior to the targeted filing date of this application. This delay was attributable to numerous patent applications, both original and continuation applications, which I was involved in drafting and filing around this time, both for the present assignee as well as other clients of this firm.

On June 6, 1995, I spoke with Darrell R. Anderson telephonically several times relating to the draft application. He advised me that he was in the process of reviewing the draft application and would be forwarding his comments to me shortly by facsimile communication. To the best of my recollection, during both of these telephone conversations the issue of inventorship was not discussed.

On June 7, 1995 I received Dr. Anderson's revisions, which I used to prepare a finalized patent application. This finalized patent application (only the pages containing changes) was then sent to Darrell R. Anderson by facsimile for his final review.

Shortly after this information was sent to Darrell R. Anderson, and prior to preparing the application transmittal information, it was realized that the issue of inventorship had not been resolved in connection with the above-identified application.

Accordingly, a telephone call was then attempted to be made to Darrell R. Anderson, both to obtain approval of the final changes of the patent application, and to confirm that he was the sole inventor. However, despite several telephone messages I was unfortunately unable to reach Dr. Darrell R. Anderson on June 7, 1995. His secretary then advised me that Dr. Anderson was out of town on that day and could not be reached. Accordingly, I then attempted to contact several other persons who are affiliated with the Assignee of this application, to resolve the inventorship issue. Unfortunately, I was advised that no one was available at that time who could provide any more specific information relating to the inventorship issue.

Therefore, given the above facts, I filed the patent application late in the evening of June 7, 1995, naming Darrell R. Anderson as the sole inventor. Shortly after filing of the patent application, I was contacted by Darrell R. Anderson. Thereupon, I discovered that through no deceptive intent, the patent application as originally filed did not name all of the appropriate inventors. In particular, I was advised that each of the above-identified persons, namely Peter Brams, Nabil Hanna and Bill Shestowsky, made an inventive contribution to one or more claims of the above-identified patent application which relates to monkey anti-B7.1 and/or anti-B7.2 antibodies, primatized forms thereof, pharmaceutical compositions containing such antibodies, and the use of such antibodies as immunosuppressants. Specifically, Nabil Hanna was involved in the initial conception of the claimed antibodies, and Peter Brams and Bill Shestowsky were

involved in the isolation and stabilization of the claimed monkey monoclonal antibodies.

After discovering the inventorship error, and after receiving the Notice of Missing Parts I diligently ascertained what information would need be submitted to the Patent Office to correct the inventorship. In particular, I consulted the MPEP regarding inventorship changes and the relevant requirements. Moreover, I consulted the relevant rules as well as discussing the matter with Darrell R. Anderson. This information was then relied upon to prepare this Petition to Correct Inventorship.

Thus, based on the foregoing, the enclosed Consent of the Assignee, Verified Statement of Facts by Darrell R. Anderson, the signed Declaration by all of the inventors is required under 37 C.F.R. §1.63 and the requisite fee under §1.17(h) it is respectfully requested that the inventorship of this application be corrected to include Peter Brams, Nabil Hanna and Bill Shestowsky.

Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS

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